

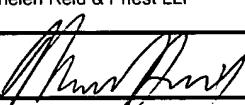
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<p style="text-align: center;">TRANSMITTAL FORM</p> <p>APR 04 2006</p> <p><i>(to be used for all correspondence after initial filing)</i></p>		Application Number	10/613,396
		Filing Date	7/3/2003
		First Named Inventor	Karsten Andersen
		Art Unit	3612
		Examiner Name	Gutman, Hilary L.
Total Number of Pages in This Submission		Attorney Docket Number	032287-102

ENCLOSURES (check all that apply)

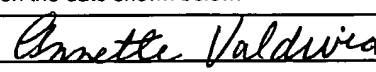
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Postcard credit card payment form Petition fee transmittal	
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm	Thelen Reid & Priest LLP		
Signature			
Printed Name	Marc Hanish		
Date	3/27/06	Reg. No.	42,626

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Karsten Andersen, et al.
SERIAL NO.: 10/613,396 Confirmation No.: 4469
FILING DATE: July 3, 2003
TITLE: SYSTEM AND PROCESS FOR TRANSPORTING WIND TURBINES
EXAMINER: Gutman, Hilary L.
ART UNIT: 3612

CERTIFICATE OF MAILING

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Name: Annette Valdivia
Annette Valdivia

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Commissioner for Patents
P.O. Box 1450
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PETITION UNDER 37 CFR 1.144

Dear Sir:

Applicants hereby petition the Commissioner pursuant to 37 CFR 1.144 and MPEP 818.03(c).

The Restriction Requirement

In paragraph 1 of an Office Action of September 16, 2004, the Examiner asserted her restriction requirement. The Applicants traversed the restriction requirement in their response mailed February 16, 2005. Thereafter in an Office Action of May 4, 2005, the Examiner made the restriction requirement final.

The restriction requirement states:

Species A is directed to Figures 3-17 and Claims 1-7 and 9-10;
Species B is directed to Figures 19-25 and Claim 8;
Species C is directed to Figures 26-32; and,
Species D is directed to Figures 33-45.

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The Restriction Requirement is Not Proper

The Restriction Requirement is not proper for two reasons. First, it is not clear, and second it is improperly based on figures rather than claims.

Restriction requirements must be clear

There can be no doubt that restriction requirements must be clear. For example, MPEP §809.02(a) requires the examiner to, “Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted.” Moreover, the heading of MPEP §814 enjoins the examiner to “Indicate Exactly How Application Is To Be Restricted.”

There are many reasons for the requirement of clarity. For example, if a restriction requirement has been imposed and thereafter an applicant files a divisional application, 35 USC §121 provides, in relevant part:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

The Court of Appeals for the Federal Circuit has explained that 35 U.S.C. §121 will not apply to remove the parent as a reference where the principle of consonance is violated:

“Consonance requires that the line of demarcation between the “independent and distinct inventions” that prompted the restriction requirement be maintained. Though the claims may be amended, they must not be so amended as to bring them back over the line imposed in the restriction requirement. Where that line is crossed the prohibition of the third sentence of Section 121 does not apply.” Gerber Garment

Technology, Inc. v. Lectra Systems, Inc., 916 F.2d 683, 688, 16 U.S.P.Q.2d (BNA) 1436, 1440 (Fed. Cir. 1990).

In the case of Geneva Pharmaceuticals, Inc., V. Glaxosmithkline Plc et al., 349 F.3d 1373; 2003 U.S. App. LEXIS 23795; 68 U.S.P.Q.2D (BNA) 186 (Fed Cir. 2003) the Court of Appeals for the Federal Circuit emphasized the importance of clarity in restriction requirements.

Section 121 shields claims against a double patenting challenge if consonance exists between the divided groups of claims and an earlier restriction requirement. Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1579 (Fed. Cir. 1991) ("Consonance requires that the line of demarcation between the 'independent and distinct inventions' that prompted the restriction requirement be maintained Where that line is crossed the prohibition of the third sentence of Section 121 does not apply.") (quoting Gerber Garment Tech., Inc. v. Lectra Sys., Inc., 916 F.2d 683, 688 (Fed. Cir. 1990)). If a restriction requirement does not clearly set forth the line of demarcation, then challenged claims could not satisfy the consonance requirement. Therefore restriction requirements must provide a clear demarcation between restricted subject matter to allow determination that claims in continuing applications are consonant and therefore deserving of § 121's protections. 349 F.3d 1373, 1381, emphasis added.

Turning now to the present case, the Applicants respectfully point out that the restriction requirement is unclear in a number of respects. The following are some examples.

The Examiner's alleged Species B and C both appear to concern allowed claims, e.g. Claim 11. Allowed Claim 11 concerns transportation of blades and nacelles. On the other hand, the Examiner's alleged Species B is directed to Figures 19-25 which concern transportation of blades as indicated at page 6, lines 16-21 of the specification. The Examiner's alleged Species C is directed to Figures 26-32 which concern transportation of nacelles as indicated at page 6, line 23 through page 7, line 1 of the specification. Accordingly, the Applicants do not understand how they could reasonably respond to the restriction requirement. It would seem to be

impossible for the Applicants to elect one of the Examiner's alleged species and still maintain Claim 11.

The Restriction Requirement does not mention Claim 11, which the Examiner has allowed. This leads to uncertainty concerning the status of Claim 11.

As another example of the lack of clarity of the restriction requirement, the Examiner's alleged Species C is "directed to Figures 26-32" and Species D is "directed to Figures 33-45". There are at least two problems with these alleged "Species". First, the Examiner identified no claims connected with Species C or D, and identified all claims as connected to Species A or B. This defies logic. If Applicants had elected Species C or D then would they have been unable to pursue any claims? It is plain that Figures 26-32 and 33-45 relate to claims of the application. For example, Claim 11 concerns nacelles and nacelles 10 are shown in Figure 26, and Claims 1-7 are related to tower sections and tower sections 50, 250-258 are shown in Figures 33-37 and 45.

Furthermore, to the best of the Applicants' understanding, alleged Species D appears to relate to tower sections 50, 250-258, shown in Figs. 33 and 34. However, tower sections are also shown in Figures 3, 4 and 16 which the Examiner alleges are Species A. Accordingly, the Applicants do not understand how they could reasonably respond to the restriction requirement.

The Examiner's alleged Species A and D both appear to concern allowed claims, e.g. Claim 1. Allowed Claim 1 concerns transportation of tower sections. The Examiner's alleged Species A is directed to Figures 3-17 which concern transportation of tower sections 50 and 52. On the other hand, the Examiner's alleged Species D is directed to Figures 33-45 which also concern transportation tower sections 50 and 250-258. Accordingly, the Applicants do not understand how they could reasonably respond to the restriction requirement. It would seem to be impossible for the Applicants to elect one of the Examiner's alleged species and still maintain Claim 1.

A restriction requirement be based on claims, not on figures

The statutory basis for restriction requirements refers to **claims**, not figures. “If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions.” 35 USC §121 (emphasis added.)

Furthermore, the Manual of Patent Examining Procedure (MPEP) does not allow the restriction requirement imposed by the Examiner. The MPEP requires that an Examiner must base a restriction requirement on the **claims**, not the figures in an application.

The MPEP clearly requires an Examiner to base a restriction on the **claims**. There are many examples of this throughout Chapter 800, which governs restriction practice, and some of the most prominent are recited below.

“In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence.” MPEP § 806.01.

“Where the **claims** of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required.” MPEP § 806.03.

“Where an applicant files a divisional application claiming species **claimed** but not elected in the parent case . . . there should be no determination of whether or not the species **claimed** in the divisional is patentable over the species retained in the parent case since that determination was made before the requirement to restrict was made. . . . “[T]he Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or

she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. . ." MPEP § 806.04(h).

The form Outline of Letter for Restriction requires the Examiner to, "List **claims** in each group." MPEP § 817 Outline of Letter (a)(2).

Requested Relief

The Applicants request that the restriction requirement be withdrawn and a new restriction requirement be substituted as follows:

Group A directed to Claims 1-7 and 9-31.
Group B directed to Claim 8.

Applicants would respond to this restriction requirement by electing Claims 1-7 and 9-31.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,
THELEN REID & PRIEST, LLP

Dated: 3/27/06



Marc Hanish
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APR 04 2001

PETITION FEE**Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL**

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
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Application Number	10/613,396
Filing Date	7/3/2003
First Named Inventor	Karsten Andersen
Art Unit	3612
Examiner Name	Gutman, Hilary L.
Attorney Docket Number	032287-102

Enclosed is a paper filed under 37 CFR 1.144 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

This form should be included with the above-mentioned paper and faxed or mailed to the Office using the appropriate Mail Stop, (e.g., Mail Stop Petition), if applicable. For transmittal of petition fees under 37 CFR 1.17(i) see form PTO/SB/17i.

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Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

§ 1.53(e) - to accord a filing date.
§ 1.57(a) - to accord a filing date.
§ 1.182 - for decision on a question not specifically provided for.
§ 1.183 - to suspend the rules.
§ 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
§ 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

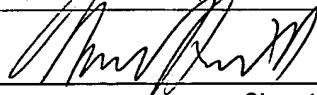
For petitions filed under:

§ 1.12 - for access to an assignment record.
§ 1.14 - for access to an application.
§ 1.47 - for filing by other than all the inventors or a person not the inventor.
§ 1.59 - for expungement of information.
§ 1.103(a) - to suspend action in an application.
§ 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
§ 1.295 - for review of refusal to publish a statutory invention registration.
§ 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
§ 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
§ 1.550(c) - for patent owner requests for extension of time in ex parte reexamination proceedings.
§ 1.956 - for patent owner requests for extension of time in inter partes reexamination proceedings.
§ 5.12 - for expedited handling of a foreign filing license.
§ 5.15 - for changing the scope of a license.
§ 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

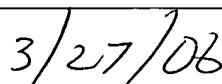
§ 1.19(g) - to request documents in a form other than that provided in this part.
§ 1.84 - for accepting color drawings or photographs.
§ 1.91 - for entry of a model or exhibit.
§ 1.102(d) - to make an application special.
§ 1.138(c) - to expressly abandon an application to avoid publication.
§ 1.313 - to withdraw an application from issue.
§ 1.314 - to defer issuance of a patent.



Signature

Marc Hanish

Typed or printed name



Date

42,626

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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